REMARKS

Changes to Claims

Claims 53 and 54 have been cancelled, and new claims 62-65 have been added herein. Claim 62 is in independent form, with claims 63-65 depending therefrom.

Claims 52-53 had further limited the applicator of claim 29 to be a mascara brush, and a doe foot applicator, respectively. Claim 52 was amended herein to be in Markush form, and limit the applicator to be from the group consisting of those two products, permitting the cancelling of claim 53.

Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a) because they failed to show the "spring means to be seated against said lip" on lines 16-17 of claim 55. A new drawing sheet has been added with Figures 15, 16, 17A, and 17B. Figure 15 is merely a side view of the container of figure 2. FIG 16 is a cross-sectional view taken through the container of FIG. 15. The details shown in FIG. 16 had not been illustrated in any of the previously submitted drawing figures, however, it is an exact copy, except for the length depicted for the container, of FIG. 5 in U.S. Patent No. 5,526,960. The disclosures of U.S. Patent No. 5,526,960, also held by Applicant, were incorporated by reference in paragraph 41 of the published application (2004/0234321), which stated:

> ...The arrangement of the rollerball and spring are described in more detail in our U.S. Pat. No. 5,526,960, the disclosures of which are incorporated herein by reference...

Therefore, the details disclosed by FIG. 16 of the new sheet do not constitute new matter.

The Examiner's objection, as above noted, also stated that "The drawings must show

every feature of the invention specified in the claims." Since new claims 62-64 are drawn to the threaded cap of FIG. 1C being inserted into the sleeve 11 in two different embodiments, FIG. 17A and FIG. 17B have also been added to the new drawing sheet. This arrangement of the threaded caps in sleeve 11 does not constitute new matter. The arrangements were disclosed in paragraphs 38 and 39 of the published application, which are excerpted below, with emphasis on the appropriate sections:

> [0038] The dual cosmetic container 10 of the present invention has ... In one embodiment, the sleeve may have two sections 14 and 15 which are connected by a sidewall 16...
>
> [0039] In one embodiment, the sections 14 and 15 may have a pair of conventional threaded caps, see FIG. 1C, inserted into the sleeve with the caps in a head to head relationship. The caps have a side wall 17, an end wall or head wall 18 and an open end 19, the interior of which may be threaded. When two caps are inserted into the sleeve, the end wall 18 of each are typically in contact with each other or the sidewall 16. The open ends of the sleeve 12 and 13 correspond to the open end of the caps 19. The body or sleeve 11 may be any length but it is preferably only of sufficient length to contain the pair threads or other receiving means for receiving a pair receptacles as well as the center wall, if present, that separates the products contained in each receptacle. The sleeve 11 may be made of any suitable material such as a metal or plastic, preferably a polished of matte metallic finish. Where caps are inserted into the sleeve, the central body 11 may also be any length but is preferably only of sufficient length to accommodate the caps at the first and second ends and the end walls of the caps...

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claim 55 and claims 57-61 under 35 U.S.C. § 112, second paragraph, as failing to comply with the written description requirement, because the claims contain "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." The Examiner cited three

specific instances for the rejection. In regard to the limitation in lines 28-29 of claim 55- a "contoured shape that changes from a convex surface to a concave surface"- that limitation has herein been removed from the claim. Each of the other two instances for the rejection is respectfully traversed, as follows.

First, the Examiner stated: "While the original specification discusses the roller ball having a surface roughness depending on the consistency of the product to be dispensed, nowhere does not teach the limitations in lines 19-21 of claim 55."

Paragraph 45 of the published application states, among other things, the following:

> ...The surface of the roller ball be smooth or slightly roughtened depending on the consistency of the product to be dispensed...

Per the last amendment, paragraph 45 was modified to be grammatically correct, without any substantive changes being made, and now reads as follows:

> ...The surface of the roller ball may be smooth or slightly roughened depending on the consistency of the product to be dispensed...

The limitations rejected by the examiner, at lines 19-21 of claim 55, have been herein amended to delete reference to measurement ("a measure of"). The remaining key elements or phrases are underlined as follows:

> ...said first roller ball having a surface roughness calibrated for optimal delivery of said product, said surface roughness being determined according to said product's viscosity;

Each of those elements or key phrases, as underlined above, are found directly in paragraph 45 of the specification, albeit through use of alternative, but fully enabling, language.

The first key portion of the limitation- "a surface roughness calibrated for"- is the functional equivalent of the phrase "smooth or slightly roughened depending on." The state of being smooth or slightly roughened, is referred to by one skilled in the relevant art as "surface

roughness" or "surface finish." In the United States, standardization for such "roughness" or "finish" of a manufactured part is established by the American Society Mechanical Engineers, and is published in ASME Y14.36M-1996. While use of the word "calibrated" may appear to convey a need for an elaborate process or measurement device, the definition of "calibrated" from Merriam-Webster's dictionary, available at http://www.thefreedictionary.com/calibrated, is simply as follows:

> cal·i·brate (kăl'ə-brāt')
> *tr.v.* cal·i·brat·ed, cal·i·brat·ing, cal·i·brates
> 1. **To check, adjust, or determine by comparison with a standard** (the graduations of a quantitative measuring instrument): *calibrate a thermometer.*
> 2. To determine the caliber of (a tube).
> 3. **To make corrections in; adjust**: *calibrated the polling procedures to ensure objectivity*

All that is invoked by that portion of the claim is that the surface roughness, according to ASME standards, must be adjusted to the consistency of the product being dispensed.

The second portion of the key language in that limitation- "for optimal delivery of said product"- is simply a restatement of the specification's disclosure that the roller ball would have roughness "depending on the ... product to be dispensed." Being optimal is just what is "most favorable or desirable" (http://www.thefreedictionary.com/optimal), and both the specification and claims (see claims 8, 21, 22 and 61) stated that the products could be as distinctly different as a liquid perfume or a cream, which would necessarily require some adjustment to the ball to permit a sufficient flow of product.

The last portion of the key language- "said product's viscosity"- is also directly traceable to the language in the specification referring to the "consistency" of the product. The definition of "consistency," from the Merriam-Webster online dictionary, which is available at http://www.merriam-webster.com/netdict/consistency, is as follows:

> 1 a *archaic* : condition of adhering together : firmness of material substance b : firmness of constitution or character : PERSISTENCY
> 2 : **degree of firmness**, density, **viscosity**, or resistance to movement or separation of constituent particles <boil the juice to the consistency of a thick syrup>

The term "consistency" has both scientific usage and other more everyday uses, but in this instance, the specification was clearly seeking to adjust or "optimize" the surface roughness of the rollerball according to the particular product to be dispensed, be it a product having a thin consistency (low viscosity), such as liquid perfume, or a product having a thick consistency (high viscosity), such as a cream. Therefore, the specification does teach the limitations in lines 19-21 of claim 55.

Secondly, the Examiner rejected the "cantilevered rod" in line 2 of claim 57 as being new matter. That limitation is derived from paragraph 44 of the published application, as follows:

> [0044] FIG. 3 shows the container of the present invention is for ... The brush 30 may be attached to the inside of the cap by a shaft 31, generally located toward the center of the inside top surface of the cap in the sleeve. By the term cap is meant a cap as shown in FIG. 1C or the threaded interior of the sleeve where the side wall 16 constitutes the surface for appending the shaft.

The terms shaft and rod are readily interchangeable, and use of one rather than the other does nothing to suggest new matter. Furthermore, use of the word "cantilever" is simply a term well known in the art that succinctly captures the underlined description of the "shaft" being attached to the cap, and extending therefrom. The term "cantilevered rod" is also aptly utilized in view of Figure 4, which shows the shaft 31 extending from the cap.

The definition of "cantilever" from an (see http://www.thefreedictionary.com/cantilever) supports such usage:

can·ti·le·ver (kăn'tl-ē'vər, -ĕv'ər)
n.
1. **A projecting structure, such as a beam, that is supported at one end** and carries a load at the other end or along its length.
2. A member, such as a beam, that projects beyond a fulcrum and is supported by a balancing member or a downward force behind the fulcrum.
3. A bracket or block supporting a balcony or cornice.
v. can·ti·le·vered, can·ti·le·ver·ing, can·ti·le·vers
v.tr.
To construct as or in the manner of a cantilever.
v.intr.
To extend outward as or in the manner of a cantilever.

Therefore use of the limitation does not constitute new matter.

Applicant believes that with the removal of the limitation regarding the contoured shaped changing from convex to concave, with removal of the reference to "a measurement," and with the above explanations, that these claims rejected by the examiner (55 and claims 57-61) are now in compliance with the written description requirement of 35 U.S.C. § 112, second paragraph.

Claim rejections - 35 U.S.C. § 103

The Examiner has rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,897,626 to Bratby-Carey, in view of U.S. Patent No. 2,663,891 to Hanryon and U.S. Patent No. 6,276,856 to Pieper. Also, the Examiner has stated in this Office Action, and previously, that the claims are "being examined as best understood." Although independent claims 1 and 41 have evolved over a substantial period of time with limitations being therein inserted throughout that period, all of the limitations of claim 55 (added per the last amendment) and new claim 62 (added herein) were constructed at one time with the intent of claiming the invention in a more concise and more clearly organized sequence (see segregation of elements using sub-sections- (a), (b)...). The sequence was so constructed to assist the Examiner in the examination process. As such, this discussion and argument is particularly

directed to claims 55 and 62, to help in better conveying the invention to the Examiner.

The Examiner's continued rejection of the claims over Bratby-Carey, in view of Hanyron and Pieper, is respectfully traversed. In addition to the amplified arguments of the previous amendment, Applicant further argues that none of the cited prior art teaches or suggests use, in combination with the elements of claims 55 and 62, of a roller ball that has its surface roughness adjusted to achieve a more favorable delivery of product in accordance with the thickness of such product being dispensed. Hanryon uses an ordinary ball, and merely states in its description, at Col. 2, lines 12-13, that "The ball 7 is preferably formed of a suitable plastic material." There was no mention, or even any consideration given anywhere in the cited references, to such a significant improvement whereby dispensing of varying viscosity products could be accommodated from a cosmetics container. Furthermore, as argued above, this limitation (also added herein to claims 1 and 41) was properly disclosed under the written description requirements of 35 U.S.C. § 112 within the original application. Applicant believes that this limitation, as herein amended, as well as the others previously cited, overcomes the Examiner's obvious rejection. The Examiner had not fully considered the surface roughness limitation, having viewed it as new matter. Therefore, applicant believes that the Examiner should withdraw the rejection.

CONCLUSION

For the foregoing reasons, applicant believes the claims are now in condition for allowance.

Respectfully submitted,

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